

Customer No. 27061

Patent
Attorney Docket No. **Old:** GEM-30834
New: GEMS8081.022

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Kennedy, Ronald G.
Serial No. : 09/474,418
Filed : December 29, 1999
For : System and Method For Remote Servicing of In-Field Product
Group Art No. : 2143
Examiner : W. Vaughn

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

Mailing

- ☐ deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 CFR 1.8(a)

37 CFR 1.10

- ☐ with sufficient postage as first class mail ☐ As "Express Mail Post Office to Addressee" Mailing Label No.

Transmission

- ☐ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Examiner W. Vaughn at the Patent and Trademark Office.
☒ transmitted by EFS-WEB addressed to Examiner W. Vaughn at the Patent and Trademark Office.

Date: July 19, 2006

/Robyn L. Templin/
Signature

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER
MAILED MAY 19, 2006

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer mailed May 19, 2006.

REPLY BRIEF

Claims 1-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jago et al. In the Examiner's Answer mailed May 19, 2006, the Examiner maintained the rejection of claims 1-24 and dismissed all of the arguments set forth by Appellant in the Appeal Brief of March 13, 2006. In response, Appellant would like to address some of the comments made by the Examiner and reinforce some of the arguments that seem to have been misconstrued.

In the Examiner's paragraph **(10) Response to Argument**, and in response to Appellant's argument that there is insufficient motivation or suggestion to combine the teachings of Wood et al., Jago et al. and Friz et al., and that the combination thereof is the result of impermissible hindsight, the Examiner stated that "the motivation is to enable image scanning devices such as ultrasound scanning apparatuses to be connected to a centralized system/server in a communication network, so that users including doctors and other health professionals to share information related to scanned images of patients in an interconnected network." Examiner's Answer, May 19, 2006, p. 5 [quoting Wood et al.]. The Examiner further stated that "[s]ince the concept of the applied prior art and the concept of the claimed novelty are indistinguishable, it is safe to believe that the alleged impermissible hindsight is not true." Id. While Appellant does not necessarily disagree with the rather general motivation that the Examiner quotes from Wood et al., Appellant respectfully believes that there still is no motivation to combine the prior art to achieve the current invention. The Examiner's claim that "the concept of the prior art and the concept of the claimed novelty are indistinguishable" cannot be held to be reasonable in light of what is disclosed in the references as compared to what is called for in the current claims. As set forth by the Appellant previously regarding the current invention:

The Specification [] states that, "for non-networked systems, there is a need to directly connect the in-field product to the on-line service center to allow the field engineers to utilize current service tools in order to bridge a customer system with the on-line service center" and that "[s]uch a system would be particularly useful for systems that do not have the requisite communication software to connect to the on-line service center directly." Specification, pg. 3, lns. 10-14. "It would therefore be desirable to have a system and technique for the remote servicing of the in-field product that can communicate with diagnostic medical systems that do not have the application software that allows for communication with the remote resources such as the on-line service center", "[i]t would also be advantageous to have a system that utilizes service tools that are already widely used by field support personnel", and "it would also be advantageous to have a system that could receive diagnostic evaluations and data from the on-line center, even with a non-networked system." Id., pg. 3, lns. 15-21.

Appeal Brief, March 13, 2006, pp. 6-7. The combination of references suggested by the Examiner would not result in a system as described above. In regards to the combination of Wood et al. and Jago et al., Wood et al. discloses a system which “make[s] it possible for physicians to remotely access, control, and perform diagnoses using their ultrasound systems over a network such as the World Wide Web with no special hardware requirements.” Wood et al., Abstract, (emphasis added). Jago et al. is directed to imaging library data access and management. Jago et al., Abstract. Jago et al. states that “the ultrasound system 10 includes a HyperText Transfer Protocol (HTTP) server 30” and that “server 30 makes the diagnostic information of the ultrasound system 10 available to users connected to the access the ultrasound system through a communication unit.” Jago et al., col. 3, lns. 20-30. Both Wood et al. and Jago et al. disclose in-field devices that are configured for direct remote communication. To conclude that one of ordinary skill in the art would be motivated to combine these references to achieve a non-networked system configured to allow for communication with a remote on-line service center is contrary to the teachings of the art of record.

With regard to the combination of Jago et al. and Friz et al., Friz et al. is directed to a laser printer array system connected to a plurality of medical imaging devices. Friz et al., Abstract. That is, the laser imaging system of Friz et al. is operable with a system of Jago et al. or Wood et al. Any such combination would result in a medical imaging system connected to a medical image printing system. That is, the system of Friz et al. does not provide service to an in-field product as called for in the present claims, but merely acquires data therefrom and dispatches service personnel responsive thereto. Combining the system of Friz et al. with Jago et al. results in a system wherein the imaging system of Jago et al. is connected to a laser medical imager system of Friz et al. The system of Friz et al. does not service, update, or communicate other than to receive data from the imaging system of Jago et al. Any motivation to combine the systems of Jago et al. and Friz et al. adds nothing to the respective systems disclosed therein.

In light of the disclosures of the current invention and the prior art, it seems apparent that the ‘motivation’ to combine the references in the manner suggested by the Examiner has been derived directly from Appellant’s disclosure. As the art of record fails to teach or suggest a combination thereof or achieve a system in accordance with the present claims and as the combination of the prior art references is the result of impermissible hindsight, the motivation or suggestion to combine the references in the manner done by the Examiner is also absent.

The Examiner also states that Appellant is incorrect in asserting that the prior art teaches away from the claimed invention. First the Examiner states that “the prior art’s mere disclosure

of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” and that the medical devices of the prior art are “readily capable of direct connection with the network” do not teach away, but show “a step ahead feature that facilitates the connectivity of these image scanning devices.” Examiner’s Answer, supra at 7-8. The Examiner then sets forth another argument wholly opposed to that which is set forth above, stating that, at the time of the invention, medical scanning devices did not come with a built in connection and “connectable features such as modems and Ethernet connectivity were not a standard, but add-ons, which implies that the scanning (ultrasound) systems... were devices ‘not readily capable of direct connection’ as recited by the inventive entity.” Id. at 8. The Examiner cannot have it both ways. At one point, the Examiner identifies the prior art as disclosing a medical device readily capable of direct connection, and then immediately thereafter it is described as not readily capable of direct connection.

Regardless of this discrepancy, Appellant reiterates that both Wood et al. and Jago et al. disclose in-field devices that are configured for direct remote communication and are “readily capable of direct connection”. To conclude that one of ordinary skill in the art would be motivated to sever these direct remote features is a suggestion that is diametrically opposed to the art of record. The references teach away from the claimed invention because they are already capable of direct communication. This is not a “step ahead” feature as characterized by the Examiner, but rather a feature that does in fact teach away from the claimed invention. One skilled in the art would not be motivated to design a system as called for in the current claims when looking at a system that is actually readily capable of direct connection to a network. The present invention solves a problem looked over by these prior art references. That is, how to communicate before the device is where Wood et al. and Jago et al. are at.

The Examiner also rejected Appellant’s argument that combining the cited references does not result in the claimed invention. With respect to the combination of Wood et al. and Jago et al., Appellant asserts that the result would be a device that has a redundant communication link with the remote system, each of which is a direct link. In regards to the combination of Friz et al. and Jago et al., the result would be an imaging system connected to a laser medical imager system, wherein the system of Friz et al. does not service, update, or communicate other than to receive data from the imaging system of Jago et al. In response to Appellant’s argument, the Examiner states that “another benefit when combining the prior art of record as noted by the appellant does not negate the combined teachings for purposes of avoiding the prior art as it is already properly applied to the claims....” Id. at 11. Appellant respectfully disagrees with the

Examiner's assessment of the prior art. What the Examiner characterizes as "another benefit" of the prior art is in fact a disclosure thereof that teaches or suggests a configuration entirely different from that which is called for in the current invention. That is, neither the combination of Wood et al. and Jago et al., nor the combination of Jago et al. and Friz et al., disclose a system as called for in the present claims.

That is, assuming that Wood et al. and Jago et al. were combinable, the combination of the disclosures thereof does not yield the claimed invention. The nature of both of these references is disclosed in the Background of Appellant's Application. That is, both systems include an in-field device that is readily capable of remote communication, be it with a user of the device such as a doctor in Jago et al. or with a plurality of local imaging devices as in Wood et al. These are the very systems that are addressed in the present Application as cited above and fail to resolve the issue of remote communication with devices that are not enabled for such connectivity. The combination of these systems does not resolve the updating shortfalls addressed by the presently claimed invention. The art of record discloses no more than the same problems discussed in the Background of Appellant's Application as cited above. Combining the references does not result in an in-field product at a customer site that is not readily capable of direct communication with an on-line center and at least one portable service interface operable with the in-field product at the customer site and having software for communication with the on-line center as called for in the present claims. The combination of Jago et al. and Wood et al. would simply result in an in-field device that has a redundant communication link with the remote system, each of which is a direct link. To conclude otherwise is contrary to the express disclosure of the references.

In regard to the combination of Jago et al. and Friz et al., any such combination would result in a medical imaging system connected to a medical image printing system. Servicing the printing system of Friz et al. has no applicability to the system service of the medical devices connected thereto. Friz et al. states that "the software system can be configured to automatically send the reports to users of the laser imagers, automatically initiate and order to send additional imaging media, and automatically initiate a request for dispatch of a service technician in response to an error condition." Friz et al., col. 3, lns. 37-42. That is, the system of Friz et al. does not provide service to an in-field product as called for in the present claims, but merely acquires data therefrom and dispatches service personnel responsive thereto. Combining the system of Friz et al. with Jago et al. results in a system wherein the imaging system of Jago et al. is connected to a laser medical imager system of Friz et al. The system of Friz et al. does not service, update, or communicate other than to receive data from the imaging system of Jago et al.

The disclosure of Friz et al. does not overcome the shortcomings of Jago et al, Wood et al., or any combination thereof, to achieve a system as called for in the present claims. Accordingly, even should Jago et al. and Friz et al. include a motivation to combine the references in the manner suggested by the Examiner, that combination is unable to result in the presently claimed invention.

Thus, the combination of the prior art does not disclose “another benefit” in addition to the teachings of the current invention as is suggested by the Examiner. Rather, that which is disclosed by the prior art, and the resulting combination thereof, fails to achieve the current invention and set forth the elements called for in the claims therein.

In the Appeal Brief, Appellant also argued that, as quoted by the Examiner, “none of the prior art of record as applied teaches, suggests interfacing between the online center and the in-field product with the portable service interface as recited in claim 10.” Examiner’s Answer, supra at 11-12. In response to Appellant’s arguments, the Examiner stated that “Jago/Wood disclosed a portable interfacing device #304 connected to the image scanning devices via Ethernet line and the portable interfacing device, the portable interfacing device further connected to a central site through the connection capability of the portable interfacing device #306 having therein modulation/de-modulation module...” Id. at 12. The Examiner has mischaracterized the disclosure of Jago et al. and what is contained therein. The “portable interfacing device[s]” 304, 306 identified by the Examiner are in actuality an Ethernet hub 304 and a modem 306. These devices are not a portable interfacing device as described in the Specification of the current invention.

The Application describes the portable interfacing device as a device, preferably a laptop computer 22-22a, configured with appropriate connectivity and diagnostic interface software to selectively link the various systems disclosed to an on-line center. Specification, p. 7, lns. 7-12. Each portable service interface or laptop 22-22a has remote servicing communications software associated therewith through which the in-field products 26, 30, 32, 34 can be configured, evaluated, serviced, maintained, upgraded, or simply monitored by the on-line center 16, which also has access to service software to service in-field product remotely. Id. at. 8, lns. 8-12. The laptops or other portable service interfaces 22-22a are required since they are the only locations at the customer site where the software for connecting to the on-line center 16 resides. Id. at 8, lns. 24-26. The in-field products at the particular customer sites for which the invention is applicable lack specific connectivity software which would normally provide the on-line center 16 with the ability to dial up the medical image scanners or other in-field products in order to conduct the desired on-line remote servicing function. Absent this capability, the systems are considered non-

networked with the on-line center, and therefore require a bridge or interface, such as the portable service interfaces 22-22a, to make the desired connections. Id. at 8, lns. 24-26 and at 9, lns. 1-6. The Ethernet hub 304 and the modem 306 identified by the Examiner clearly do not have the capability of the portable interfacing device as described above and as set forth in the current invention. To suggest as much is contrary to what is disclosed in the prior art. As such, that which is set forth in the claims of the current invention is not taught, suggested or disclosed in any of the prior art references cited by the Examiner.

In summary, Appellant believes that the Examiner has failed to show how the teachings and disclosure of the prior art renders the current invention obvious. Appellant has set forth evidence showing that, not only is there no motivation to combine the references as suggested by the Examiner, but additionally that the combination thereof still fails to teach, disclose, or suggest that which is called for in the current claims. Appellant has set forth in detail in the Appeal Brief of March 13, 2006 evidence showing such and has summarized some of these arguments above in response to statements made by the Examiner in the most recent Examiner's Answer.

In view of the above remarks, Appellant respectfully submits that claims 1-24 are patentably distinct over the art of record. Accordingly, Appellant requests that the Board direct that each of the above referenced outstanding rejections reliant in whole or in part on Wood et al., Jago et al. and Friz et al. be withdrawn.

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-376-5170 ext. 15
krr@zpspatents.com

Dated: July 19, 2006
Attorney Docket No.: GEMS8081.022

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com